

REMARKS

The subject application has been carefully considered in view of the Office Action (Final) of January 13, 2004. Accordingly, Claims 4, 5, 6 and 16 have been cancelled to reduce the issues for Appeal. Claim 1 has been amended by incorporation of the subject matter of the cancelled Claim 5, and Claim 15 is amended by the incorporation of the subject matter of cancelled Claim 16. This should not raise new issues nor require further search as cancelled Claims 5 and 16 were included in the rejection of the claims in view of Wenkman.

The cover page of the January 13, 2004, Action indicated that all pending Claims 1-9, 15 and 16 were rejected; but the body of the Action only referred to Claims 1-9 (Claims 15 and 16 were not specifically mentioned). Paragraph 4 of the Action does refer to the parallel fold lines, which are only recited in Claim 15. Accordingly, Applicant considers, for purposes of this response, that all claims (including Claims 15 and 16) stand rejected as being unpatentable over Wenkman. A call to the Examiner confirmed that this was the case.

The Drawings

The drawings are objected to as not showing the "easel forming cuts" specified in the claims. However, these cuts are shown at 26 in the as-filed Figures 1-3, 7 and 8. The amendment filed on May 23, 2003, included an amendment to pages 4 and 8 that added the reference numeral "26" to the specification. A non-final Office Action of August 11, 2003, responding to the May 23, 2003, Amendment did not raise any issue with respect to this amendment. Accordingly, no correction of the drawings appears necessary.

The Rejection and Argument

Claims 1-9 (and 15, 16) are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenkman. The reference is said to disclose the claimed elements except for the mailer rear panel connected to the mailer front panel by a fold line. This is an acknowledgement by the Examiner that the reference does not

disclose an arrangement including a mailer front panel and a mailer rear panel connected along a fold line as claimed. The Examiner addresses the missing element (the rear mailer panel 28) by saying it would be obvious to add another panel "in order to provide more room for the user to write" and that adding such a panel represents a "mere duplication of the essential working parts...[that]... involves only routine skill in the art".

Applicant urges that the mailer rear panel 28 is not the mere duplication of the mailer front panel 32. A duplication of parts would result in two mailer front panels having the same relationship to the remainder of the frame. For example, a duplication of the Wenkman mailer panel 8 would be another panel arranged to overlay the frame front panel 6. Adding a panel at a different position for a different purpose cannot constitute parts duplication.

The mailer rear and front panels (28, 32) do not have the same structural relationship to the remainder of the frame (frame front and rear panels 22, 24), so they cannot be duplicates. In Claim 1, the mailer rear panel is "connected to the frame rear panel" (element "c") so as to selectively dispose against "the frame front panel" (element "f"). The mailer front panel is "connected to the mailer rear panel" (element "d") to selectively dispose against "the frame rear panel" (element "f"). In the context of the specification, this construction protects both the frame front and rear panels during mailing.

Claim 15 is even more specific. As in Claim 1, the mailer rear panel is connected to the frame rear panel and the mailer front panel is connected to the mailer rear panel. In addition, the claim states that each of the fold lines connecting one panel to another "are sequentially arranged and substantially parallel one to another". In such a construction, the disposition of the four panels preclude any of them being duplicates of another as each panel bears a unique structural relationship to the others and each has its own different function.

The Examiner says that adding another mailer panel provides more writing room and therefore constitutes a mere duplication of the essential parts. Applicant again urges that providing an extra writing panel to the Wenkman structure does not necessarily provide another mailing panel. For example, an extra writing panel

could be foldably attached to the Wenkman three-panel structure at any number of locations that would not allow service as a mailer panel. The extra writing panel even could be of a smaller size so as to preclude its use as a mailer panel.

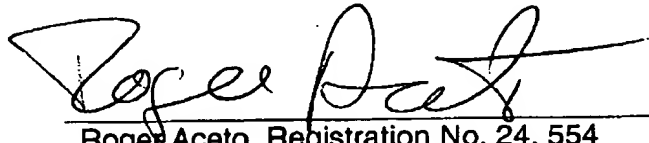
Thus, one wanting to add an extra writing panel has the choice of adding it in a variety of sizes, shapes and locations. If one chooses to add the extra writing panel to the Wenkman mailer panel, there still is a choice of size and location. Adding it so there is a third fold line parallel to the other two (Claim 15) is only one option. Regardless as to where, or how, the extra writing panel is connected to the Wenkman mailing panel, one still has any number of size choices. Thus, providing an extra panel for more writing room, even if connected to the Wenkman mailer panel, still would not result in the claimed invention.

This particularly is the case as Wenkman does not remotely suggest protecting the easel cutouts or providing more writing room. Accordingly, the recitation of intended use does result in a structural difference; namely, the size and disposition of the fourth panel must be such as to permit the claimed overlaying relationship locating the frame front and rear panels between the mailer front and rear panels. In the present invention, the addition of a mailer panel provides the incidental benefit of more writing room. In contrast, providing an additional writing panel for more writing room does not of itself provide the incidental benefit of a second mailer panel as claimed.

Accordingly, Applicant considers that the claims do patentably distinguish from Wenkman and are in condition for allowance, which action is respectfully requested. In the alternative, Applicant requests that the amendment to the claims be entered as it simplifies the issues for Appeal. The amendment of Claims 1 and 15 by the incorporation of the subject matter respectively of cancelled dependent

Claims 5 and 15 does not raise new issues nor necessitate a further search because Claims 5 and 16 currently stand rejected as being obvious over Wenkman as applied to Claims 1 and 15.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Roger Aceto", is written over a horizontal line.

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